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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/698,423

11/03/2003

Clark Easter

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4372

7590

11/22/2005

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EXAMINER

SMITH, TRACI L

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/698,423	EASTER ET AL.	
	Examiner	Art Unit	
	Traci L. Smith	3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-14,17 and 19-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,17 and 19-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is in response to papers filed on August 23, 2005.
2. Claims 1,5-6,8-11,19-20 and 31-34 have been amended.
3. Claims 3-4, 15-16 and 18 have been cancelled.
4. Claims 1-2, 5-14, 17 and 19-39 are pending.
5. Claims 1-2, 5-14, 17 and 19-39 are rejected.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-2, 5-14, 17 and 32-37 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant claims several mathematical processes such as calculations, factoring and variances that are not disclosed in the specification so as one skilled in the art would be able to make and/or use the system.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2, 5-14, 17 and 19-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over [www.4n1software.com](http://www.4n1software.com); any linkage', \*March 03, 2001 ; retrieved from the wayback machine on August 25, 2004 hereinafter referred to as 4GL in view of US Patent 6270351 B1 Roper

10. As to claims **1, 19 and 31** 4GL teaches a method, system and program of receiving dates (Pg. 1. 6).

Identifying service plans within the date range (pg. 5 1. 11)

Identifying encounters within the plan (pg. 5 1. 7).

comparing expected service with identified encounters. (Pg. 5 1. 21-23).

producing a number of shortfall or surplus encounters (Pg. 14 1. 5-6). The examiner notes interpretation of applicants amended limitations. As to Missed, missing and attempted services can be interpreted as "shortfall services". Examiner notes that it is obvious if one is tracking services for shortfalls and or surplus one needs to know the actual amount of services that were actually completed (or met). Also in order to label services as shortfall or surplus one needs to know what the base is for comparing that to (ie required). When broadly interpreted the above limitation is taught by 4GL.

11. 4GL fails to teach an automatic way to determine Roper teaches a tracking IEP database and automatically creating new IEP's. (C. 6 I. 3-5). It would have been obvious to one skilled in the art to combine the teachings of 4GL with Roper so as to allow schools and administrators to maintain an organized and structured method of complying with federal education laws.

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12. As to claim **2** 4GL teaches a method with individual education plans(IEP)(Pg. 5 1. 11).
13. As to claims **10** 4GL teaches a method comparing expected service with identified encounters. (Pg. 5 1. 21-23).
14. As to claim **5** 4GL teaches a method of comparing expected numbers with identified numbers. (Pg. 14 1. 6-7)
15. As to claims **6, 9 and 11** 4GL teaches a method of a result of shortfall or surplus of services. (Pg. 14 1. 10-13)
16. As to claim **7** 4GL teaches a method of dividing a date range into a time period. (Pg. 14 1. 29)
17. As to claim **8** 4GL teaches a method of comparing expected and identified numbers from one time period to another. (Pg. 15 1. 13-15)
18. As to claim **12** teaches a method of tracking an encounter that is reported late. (pg. 5 1. 13)
19. As to claim **13** 4GL teaches a method of providing dates encounters took place. (Pg. 5 1. 19-20)
20. As to claims **14** 4GL teaches a method for entering and storing information regarding encounter types and encounters associated with an individual service plan and provider. (Pg. 8 1. 12-16 & p. 9 1.6-8).
21. As to claim **17** 4GL teaches a method with encounters of missed services (Pg.5 1. 14-15).
22. As to claim **20** 4GL teaches a system for compliance management with a

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processor, user interface and database. (Pg. 18 1. 1-5).

electronic forms identical to paper forms so that personnel know how to fill them out on a computer that gets saved on the database. (Pg. 9 1.5-3 & 13)

IEP forms pull from banks of goals and objectives and compliance checking using the forms the user fills out to determine other information about encounters (Pg. 9. 1-2 & 6-8)

23. As to claim **21** 4GL teaches system with a terminal NT platform (Pg. 15 1. 33-34)

24. As to claims **22 and 24** 4GL teaches a system with a PC. (Pg. 18 1.9-10)

25. As to claim **23** 4GL teaches a system with a processor housed in a server (p9. 18 1. 6)

26. As to claims **25 and 30** 4GL teaches a system with a server coupled to a network (Pg. 19 1. 1)

27. As to claim **26** 4GL teaches a system with a network as the internet. (Pg. 19 1. 18-19)

28. As to claim **27 and 28** 4GL teaches a system with a server and a networking system. As to this being "coupled", coupling is inherent in any networked computer system. (Pg. 19 1. 1 and 17-20)

29. As to claim **29** 4GL teaches a system with a server to store the database. (Pg. 19 1. 12)

30. As to claims **32 and 36** 4GL teaches a system and method for tracking and reporting an individuals IEP encounters. However, 4GL fails to teach calculating

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duration services. Roper teaches a system and method for determining a students qualifications that are specifically designed for a certain threshold based on standard scores.

31. comparing expected service with identified encounters. (Pg. 5 1. 21-23).

producing a number of shortfall or surplus encounters (Pg. 14 1. 5-6). The examiner notes interpretation of applicants amended limitations. As to Missed, missing and attempted services can be interpreted as "shortfall services". Examiner notes that it is obvious if one is tracking services for shortfalls and or surplus one needs to know the actual amount of services that were actually completed(or met). Also in order to label services as shortfall or surplus one needs to know what the base is for comparing that to(ie required). When broadly interpreted the above limitation is taught by 4GL

32. As to claims **33** and **37** 4GL teaches a system and method for identifying services for an IEP, however, 4GL fails to teach converting encounters to a common unit of measurement. Roper teaches a score conversion which puts all test scores in a common unit.(Fig. 23 C. 11 I. 67). It would have been obvious to one skilled in the art at the time of invention to combine the teachings of 4GL with Roper as to make it a logical, easy and accurate comparison by having the encounters all in the same type of measurement.

33. As to claims 34-35 and 38-39 4GL teaches determing services required by an individuals IEP in a school year. Although 4GL does not explicitly teach a calendar and that calendar being a school calendar, it is understood to require a calendar in order to determine if the services frequency fall on days when school is in session and if there

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are providers available to perform these service. It is obvious to anyone who is planning or setting a schedule of events to consult the appropriate calendar while making these types of decisions.

### ***Response to Arguments***

34. Applicant's arguments filed August 23, 2005 have been fully considered but they are not persuasive.

35. As to applicants arguments regarding rejection under 35 USC 112 1<sup>st</sup> Paragraph the examiner disagrees. The applicants directs the examiners attention to pgs. 26-30 and figures 11-13 as disclosing the teachings of the mathematical processes, variances and factoring. Examiner notes in claim 1 the calculations being done are to identify the number of expected services. The section in which applicants eludes that the teaching is found merely shows a comparison of expected to actual to identify what services may or may not have taken place. The section fails to teach what calculation is done to identify the "expected" services a student needs.

36. As to applicants arguments regarding the rejections under 35 USC 103 examiner is not persuaded. Applicant argues the limitation of "comparing expected services with identified" this limitation is identical to claim 3 which is currently cancelled and was address and art applied in combination will all limitations of claim 1 as it depended from claim 1. As to applicants arguments regarding the references not teaching the limitation of "generating information indicating required services, missed services, missing services, attempted services and made up services the examiner directs applicant to



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the above rejection of these limitation where the examiner gives an explanation of the interpretation given to this limitation.

37. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, on Pg. 1 of the 4GL the reference states the challenges addressed by SETS etc" as the problems attempting to be overcome with the current system. In the Roper reference in C. 2 I. 55-64 Roper states the reference will help overcome efficiency creating, analyzing and editing IEP's, save time and money.

### ***Conclusion***

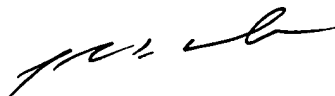
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 572-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS



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